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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/008,413	11/13/2001	Kiyoshi Hayashi	10873.836US01	2962

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EXAMINER

MERCADO, JULIAN A

ART UNIT	PAPER NUMBER
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1745

DATE MAILED: 11/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/008,413

Applicant(s)

HAYASHI ET AL.

Examiner

Julian Mercado

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 8-23-05.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 26-33 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 26-33 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Remarks

This Office action is responsive to applicant's amendment filed August 23, 2005.

Claim Rejections - 35 USC § 112

The rejection of claims 26-33 under 35 U.S.C. 112, first and second paragraph has been withdrawn. The examiner notes applicant's citation of page 7, lines 1-12 and lines 29-33 which obviates the grounds for rejection.

Claim Rejections - 35 USC § 102 and 103

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 26-33 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Uramoto et al. (JP 61-183868).

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The rejection is maintained for the reasons of record. The scope of the present claims appear to be identical if not similar to those considered in the prior Office action. As to the active material being a paste, the examiner asserts that Uramoto et al. teaches this feature insofar as being a paste type electrode.

Applicant's arguments have been fully considered, however they are not found persuasive.

It appears to the examiner that the claimed invention arguably being different from that disclosed by Uramoto et al. is premised on a treatment step (or absence thereof) by which the cobalt compounds are made. For example, applicant's remarks state that the higher solubility cobalt compound "may be a cobalt metal, cobalt hydroxide, cobalt monoxide, and cobalt sulfate, where such cobalt compound may be provided *without the treatment* of the former cobalt compound..." and that the "cobalt hydroxide, after being subjected for instance to any of the above *treatments*, results in a cobalt compound that is different from the starting material." (emphasis added)

As to the claimed invention having advantages such as forming a tight network and a fine network, thereby having an effect of high power output, this assertion is not persuasive as such properties are outside the scope of the present claims.

With respect to the claimed invention being "different from any component employed in the active material in Uramoto et al.", to what extent this difference exists or what the actual difference is between the claimed invention and the prior art appears to have been omitted from applicant's argument. If such differences are based on the cobalt hydroxide being (somehow) treated to obtain a cobalt compound different from the starting material, the examiner notes that

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independent claim 26 is strictly a product claim, although claims 27-33 are product-by-process claims. With respect to the latter group of claims, the examiner maintains that the claimed product appears to be the same or similar to the prior art product insofar as being cobalt compounds for an alkaline battery, and absent unexpected results, such differences would have been obvious to the skilled artisan as a routine modification of the product. *In re Thorpe*, 227 USPQ 964 (Fed. Cir. 1985).

The X-ray diffraction analysis chart “produced by any of the three embodiments disclosed” is noted. However, it is unclear what these three embodiments are, or, how these three embodiments relate to any of the product-by-process claims 27-33. Additionally, the diffusion angle properties are outside the scope of the present claims; notwithstanding, it has also not been shown that these diffusion angles (if claimed) are resultant properties of the active material compound and unique to the claimed process.

Regarding differences in the hardly-soluble compound such as lower solubilities or exhibition of color changes, these arguments are not persuasive as they are outside the scope of the present claims.

As to Uramoto et al. not mentioning anything as a hardly-soluble compound, in reply the examiner asserts that the term hardly-soluble is a relative term, and therefore, at least relative to one another, cobalt hydroxide is less soluble than cobalt oxide.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Julian Mercado whose telephone number is (571) 272-1289. The examiner can normally be reached on Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick J. Ryan, can be reached on (571) 272-1292. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.



JAM



PATRICK JOSEPH RYAN
SUPERVISORY PATENT EXAMINER